

REMARKS

I. Introduction

Claims 1 to 9 are currently pending.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Obviousness rejections of claims 1 to 9 (addressed together)

Claim 1 has been rejected under 35 U.S.C. 103(a) as unpatentable over the combination of Pauschinger (U.S. Patent No. 6,523,014), Sakakibara (U.S. Patent No. 6,798,463) and Cilurzo (U.S. Patent No. 6,434,526). Applicants respectfully submit that the combination of references relied upon does not render obvious claim 1 for the following reasons.

Where an invention is contended to be obvious based upon a combination of elements across different references, it is settled that there must be a suggestion, motivation or teaching to those skilled in the art for such a combination. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). This requirement prevents the use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” Ecolchem, Inc. v. So. Cal. Edison Co., 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Furthermore, given the “subtle but powerful attraction of a hindsight-based obvious-ness analysis,” we require a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Id. (emphasis added).

In the present Office Action, the Examiner relies on Pauschinger for the teachings of a) receiving an electronic data record by an information system, b) checking the data record by the information system for the presence of errors, and c) routing the data record to a receiver if the data record is error-free; the Office Action relies on Sakakibara for the teaching of storing a data record in a defined access area of the information system if the data record is faulty, and on Cilurzo for the teaching of having the data record stored in the defined access area being examinable by the sender and revisable.

In brief, Pauschinger concerns and describes a franking system in which a user provides a mailing address to a data center, which checks the address for accuracy. If the address is inaccurate and not easily correctable, the user is informed of the need to correct the address. When correct, the data center sends back a postage value to be stamped on an outgoing envelope. Pauschinger, col. 5, line 61 to col. 6, line 13. Sakakibara concerns and describes a television receiving apparatus that discriminates between a wireless TV broadcast and a cable signal (CATV) by counting a number of stations that fall within prescribed center frequencies. In this counting process, if a frequency does not fall into a particular frequency band for CATV, error frequency data is stored in an error storage area. Sakakibara, col. 7, lines 1 to 9. Cilurzo concerns and describes a speech server system in which various users provide speech inputs to a central server, and the server outputs text based on the speech. Cilurzo describes displaying the text at user locations and storing the text at "user databases" at the central location; the user can correct the displayed data and store it and the user database. Cilurzo, col. 4, lines 55 to 60.

In view of the extremely different subject matter of the cited references, and the unrelatedness of the problems each is directed to solving, it is submitted that the Examiner has impermissibly relied on hindsight in combining these substantially unrelated references. In particular, it is difficult to see how one of skill in the art in the field of franking systems (i.e., Pauschinger) would be motivated to consult the Sakakibara reference which deals with an algorithm for discriminating a TV mode from a CATV mode. It is clear that this combination comes from hindsight, whereby the Examiner was looking for a reference that had the specific teaching of storing a data record in a defined access area of the information system if the data record is faulty in order to cure the deficiencies of the Pauschinger reference -- which does not include this teaching. The same holds true for the Cilurzo reference, which also deals with completely different subject matter from the primary Pauschinger reference.

In sum, the claimed invention concerns an invoicing information system that enables the sender, who has the greatest ability to ensure correct data, to correct invoices that the information system recognizes as faulty. While the Pauschinger reference ostensibly deals with an intelligent system that checks data records for accuracy, the Sakakibara and Cilurzo references notably do not deal with such subject matter as they do not refer or concern an intelligent record-checking system.

Thus, the Examiner has looked far afield from the context and subject matter of the present invention in order to find each of the recited elements in published references. It is emphasized that the legal decisions have warned against precisely such an exercise, which is the essence of hindsight reconstruction.

Applicant accordingly maintains that the rejection of claim 1 based on the Pauschinger, Sakakibara and Cilurzo references represents a quintessential hindsight reconstruction which both Federal Circuit decisions and the MPEP have repeatedly forbidden in making an obviousness determination. It is therefore submitted that claim 1 is allowable over the references relied upon.

As each of the additional rejections of claims 2, 3, 4, 5 and 6 (each separately) and 7 to 9 (together) relies on the combination of Pauschinger, Sakakibara and Cilurzo and additional references, it is submitted that each of claims 2 to 9 is allowable at least for the reason that the combination of these three references reflects an impermissible hindsight reconstruction, and cannot render obvious the claimed subject matter they are applied against.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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